REMARKS/ARGUMENTS

Favorable reconsideration of this application light of the following discussion is respectfully requested.

Claims 12-25 are pending.

The outstanding Office Action rejects Claims 12-25 under the judicially created doctrine of obviousness-type double patenting as unpatentable over Claims 1-3, 8-11, and 14-16 of U.S. Patent No. 6,298,196; rejects Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e) as anticipated by Kori, et al. (U.S. Patent No. 5,778,064, herein "Kori"); rejects Claims 18-20 and 23-25 under 35 U.S.C. § 103(a) as unpatentable over Kori in view of Tamada, et al. (U.S. Patent No. 5,729,717, herein "Tamada"); and rejects Claims 13, 17, and 22 under 35 U.S.C. § 103(a) as unpatentable over Kori in view of Cloutier, et al. (U.S. Patent No. 5,847,771, herein "Cloutier").

Applicants note that the Information Disclosure Statement filed June 20, 2000 has not been acknowledged. Applicants respectfully request that the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the attached form.

Rejection of Claims 12-25 under the Doctrine of Obviousness-Type Double Patenting

The Final Office Action rejects Claims 12-25 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-3, 8-11, and 14 -16 of U.S. Patent No. 6,298,196. Applicants respectfully traverse the rejection.

Applicants submit herewith a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) with respect to U.S. Patent No. 6,298,196.

The filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. The "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting,

and raises neither a presumption nor estoppel on the merits of the rejection. Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 20 U.S.P.Q.2d 1392 (Fed. Cir. 1991). Accordingly, Applicants filing of the attached disclaimer is provided for facilitating a timely resolution to prosecution only, and should not be interpreted as an admission as to the merits of the obviated rejection.

Rejection of Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e)

In regard to the rejection of Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e) as anticipated by Kori, Applicants respectfully traverse the rejection for the following reasons.

To establish anticipation of Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e), the outstanding Office Action must show that each and every feature recited in Claims 12, 14-16, and 21 is either explicitly disclosed or necessarily present in Kori.[1]

The Final Office Action asserts that Kori discloses all of the features recited in Claims 12, 14-16, and 21. Applicants respectfully disagree.

Claim 1 recites a method of screening a digital recording apparatus to determine whether a digital signal may be received by the digital recording apparatus comprising, *inter alia*, steps of detecting whether the digital recording apparatus performs processing in compliance with copyright protection information and allowing a digital signal to be received by the digital recording apparatus in response to detection that the digital recording apparatus performs processing in compliance with the copyright protection information.

The Final Office Action asserts that "since the HD signal contains copy protection information, before any recording of the digital HD signal, the VCR 2 apparatus performs copy protection processing to determine whether the reproduced digital HD signal can be recorded."[2]

Accepting the above, Applicants note that, in Kori, it is assumed that the VCR 2

[1] See MPEP § 2131.

apparatus has the capacity to perform copy protection processing to determine whether the reproduced digital HD signal can be recorded. In other words, in Kori, it is assumed that the VCR 2 apparatus has the capacity to perform processing in compliance with copyright protection information. Kori does not disclose or suggest the step of detecting whether the VCR 2 apparatus performs processing in compliance with copyright protection information as a prerequisite to receiving the digital signal.

More specifically, in Kori, "VTR 2 is comprised of a head mechanism 13, an auxiliary data processing circuit 15, a VBI signal decoder 16 and a recording signal processing circuit (not shown in FIG. 6)."[3] "VBI decoder 16 extracts the VBI signal from the analog HD signal, extracts the CGMS information therefrom and supplies the CGMS information to auxiliary data processing circuit 15."[4] "Auxiliary data processing circuit 15 supplies to the recording signal processing circuit an indication of whether the HD signal is recordable (i.e., the original CGMS data is either 00 or 10), or whether the HD signal is not recordable (i.e., the original CGMS data is 11)."[5] In other words, in Kori, a recording apparatus (i.e., VTR2) is assumed to have the capacity to perform processing in compliance with copyright protection information (i.e., the CGMS data) before starting to record; therefore, in Kori, there is no need to detect whether a recording apparatus (i.e., VTR2) performs processing in compliance with copyright protection information. No where does Kori disclose or suggest the steps of detecting whether the digital recording apparatus performs processing in compliance with copyright protection information as a prerequisite to allowing a digital signal to be received by the digital recording apparatus in response to detection that the digital recording apparatus performs processing in compliance with the copyright protection information, as recited in Claim 1. Thus, Kori does not offer an

[2] Office Action, pages 1-2.
[3] Col. 5, lines 40-42 of Kori.
[4] Col. 5, lines 45-48 of Kori.

advantage of displaying an incompatibility message (or taking some other kind of action) when an incompatible copy protection scheme is detected.

Accordingly, Applicants submit that Claim 12 is patentable and the rejection of Claim 12 under 35 U.S.C. § 102(e) should be withdrawn. Independent Claims 16 and 21, although of different scope and/or statutory class, include features similar to those in Claim 12 discussed above. Claims 13 and 14 depend from Claim 12. Thus, Applicants respectfully request that the rejection of Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e) be withdrawn as well.

Rejection of Claims 18-20 and 23-25 under 35 U.S.C. § 103(a)

In regard to the rejection of Claims 18-20 and 23-25 under 35 U.S.C. § 103(a) as unpatentable over Kori in view of Tamada, Applicants respectfully traverse the rejection for the following reasons.

Effective November 29, 1999, 35 U.S.C. 103(c) provides that subject matter developed by another which qualifies as "prior art" only under one or more of subsections 35 U.S.C. 102(e), (f) and (g) is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made.

The present Application was filed on March 3, 2000 as a Continuation of U.S. Application Serial No. 08/922,862, filed on September 3, 1997, and in turn claims priority to JP 08-255464, filed on September 5, 1996. Kori was filed on March 28, 1996 and issued on July 7, 1998.

Applicants acknowledge that Kori may be applied as 102(e) prior art,[6] rendering the obviousness rejection a 103(c) rejection. In this regard, Applicants submit that the present Application and the Kori reference were at the time the invention was made, owned by, or

[5] Col. 6, line 67-col. 6, line 4 of Kori.

subject to an obligation to an assignment to, Sony Corporation. Accordingly, application of the Kori reference under 35 U.S.C. § 103(a) is improper. Thus, Applicants respectfully request that the rejection of Claims 18-20 and 23-25 under 35 U.S.C. § 103(a) be withdrawn.

Rejection of Claims 13, 17, and 22 under 35 U.S.C. § 103(a)

The outstanding Office Action rejects Claims 13, 17, and 22 under 35 U.S.C. § 103(a) as unpatentable over Kori in view of Cloutier. Applicants respectfully traverse the rejection.

As discussed above with respect to rejection of Claims 18-20 and 23-25 under 35 U.S.C. § 103(a), application of the Kori reference under 35 U.S.C. § 103(a) is improper. Thus, Applicants respectfully request that the rejection of Claims 13, 17, and 22 under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

Accordingly, in view of the foregoing amendments and remarks, it is respectfully submitted that the present application, including Claims 12-25, is patentably distinguished over the prior art. If the Examiner agrees, the Examiner is invited to contact the undersigned, so that the undersigned can file a terminal disclaimer to formally put the application in condition for allowance.

Respectfully submitted,

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[6] Based on the filing date of Kori.